

ESTTA Tracking number: **ESTTA13805**

Filing date: **08/23/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Nextel Communications, Inc.
<b>Granted to Date of previous extension</b>	08/22/2004
<b>Address</b>	Nextel Communications, Inc. 2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES

<b>Attorney information</b>	John I. Stewart, Jr. Crowell & Moring LLP 1001 Pennsylvania Avenue, NW Washington, DC, DC 20004 UNITED STATES jstewart@crowell.com, kherrmann@crowell.com, wsauers@crowell.com Phone:(202) 624-2500
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#### Applicant Information

<b>Application No</b>	78235618	<b>Publication date</b>	02/24/2004
<b>Opposition Filing Date</b>	08/23/2004	<b>Opposition Period Ends</b>	08/22/2004
<b>Applicant</b>	Motorola, Inc.		

**Goods/Services Affected by Opposition**

Class 009. First Use: 19910506 First Use In Commerce: 19910506  
All goods and services in the class are opposed, namely: Two-way radios

**Attachments**

Notice of Opposition (Executed).pdf ( 4 pages )

**Signature**

/John I. Stewart, Jr./

**Name**

John I. Stewart, Jr.

**Date**

08/23/2004

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE TRADEMARK TRIAL AND APPEAL BOARD**

NEXTEL COMMUNICATIONS, INC.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opp. No.: _____
	)	App. No.: 78/235,618
MOTOROLA, INC.,	)	Pot. Mark: SENSORY MARK
	)	(911 Hz tone)
	)	
Applicant.	)	
	)	

**BOX - TTAB - FEE**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

**NOTICE OF OPPOSITION**

Honorable Commissioner:

NEXTEL COMMUNICATIONS, INC. ("Opposer"), a corporation duly organized and existing under the laws of the State of Delaware, located and doing business at 2001 Edmund Halley Drive, Reston, VA 20191, believing that it will be damaged by registration, hereby opposes Application Serial No. 78/235,618, filed April 9, 2003, under the Trademark Act of 1946, as amended ("Lanham Act"), in the name of MOTOROLA, INC. ("Applicant").

The grounds for opposition are as follows:

1. Opposer is one of the largest providers of cellular telephone and dispatch communications services in the United States, and currently has over 12 million subscribers to its services nationwide.

2. Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefor, for sale by Opposer for use with Opposer's cellular telephone and dispatch services.

3. Applicant manufactures phones and accessories for Opposer's direct competitors.

4. On April 9, 2003, Applicant filed an application for registration of an electronic sound consisting of a tone at 911 Hz played at a cadence of 25 milliseconds (ms) on, 25 ms off, 25 ms on, 25 ms off, 50 ms on ("the 911 Hz Tone Application"). The 911 Hz Tone Application was assigned Serial No. 78/235,618, and was published for opposition in the Official Gazette on February 24, 2004. As published for opposition, the goods recited in the 911 Hz Tone Application are "[t]wo-way radios."

5. The 911 Hz Tone Application was filed under Section 1(a) of the Lanham Act, and claimed May 6, 1991, as the date of first use and the date of first use in commerce.

6. On October 17, 2003, the United States Patent and Trademark Office ("USPTO") issued an Office Action in connection with the 911 Hz Tone Application, requiring a description of the 911 Hz tone and a specimen evidencing use of the 911 Hz tone in commerce.

7. On October 17, 2003, Applicant submitted a response to the USPTO Office Action. The response included a description of the 911 Hz tone as follows:

“[t]he mark is an electronic chirp consisting of a tone at 911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON.”

8. Applicant’s response to the USPTO Office Action also included a specimen of use in the form of a compact disc described as “[a] sound file that contains a sound that emanates from a two-way radio to alert user or receiver of an incoming call or the availability to speak.” The specimen was asserted to have been in use in commerce since at least as early as the filing date of the application.

9. Upon information and belief, Applicant has not used the 911 Hz tone in commerce in connection with the goods listed in the 911 Hz Tone Application, in derogation of Sections 1 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1127.

10. Upon information and belief, the 911 Hz tone is not inherently distinctive and has not acquired distinctiveness as to the goods listed in the 911 Hz Tone Application, in derogation of Sections 1, 2, and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052, 1127.

11. Opposer avers that, as it is a purchaser and potential purchaser of communications devices incorporating two-way radio capabilities from Applicant and other vendors of such devices, and as Opposer also sells such devices to end users, it will be damaged by the unjustified registration by Applicant of the 911 Hz tone as set forth in the 911 Hz Tone Application.

**WHEREFORE**, Opposer, NEXTEL COMMUNICATIONS, INC., believes and avers that it will be damaged by registration of the 911 Hz tone as aforesaid, and prays that said Application Serial No. 78/235,618 be rejected, that no

registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed JOHN I. STEWART, JR., JEFFREY D. SANOK, and MICHAEL H. JACOBS, members of the law firm of **CROWELL & MORING LLP**, and members of the Bar of the District of Columbia, to prosecute this Opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

**John I. Stewart, Jr.**  
Crowell & Moring LLP  
1001 Pennsylvania Avenue, NW  
Washington, DC 20004  
Telephone No.: (202) 624-2500  
Facsimile No.: (202) 628-5116

The filing fee in the amount of \$300.00 should be charged to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92133US). Please credit any overpayments or charge any additional fees to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92133US).

Respectfully submitted,



John I. Stewart, Jr.  
Attorney for Opposer

August 23, 2004

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